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10/722,051	11/26/2003	Lester F. Ludwig	A8681	8319

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EXAMINER

REILLY, SEAN M

ART UNIT	PAPER NUMBER
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2153

MAIL DATE	DELIVERY MODE
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06/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/722,051

Applicant(s)

LUDWIG ET AL.

Examiner

Sean Reilly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 37-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This Office action is in response to the appeal brief filed on December 18, 2006 and the amendment filed on March 15, 2007. Claims 37-70 are presented for further examination. The claims filed on March 15, 2007 were previously indicated allowable however upon further search and consideration these claims are no longer deemed allowable. An interview was conducted with Applicant on April 30, 2007 regarding this application and the other co-pending applications claiming similar subject matter. During this interview various claim amendments were discussed however agreement could not be reached. Based on the discussions during this interview it is expected that each of these related applications will proceed to the Board of Appeals and Patent Interferences. As requested by Applicant, the amendment filed on March 15, 2007 is entered.

In view of the Appeal Brief filed on December 18, 2006, PROSECUTION IS HEREBY REOPENED. A new rejection rationale is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:


(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

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been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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1. The instant claims are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of the following set of applications 11/622,583, 11/622,627, 11/623,177, 11/623,387, 11/623,630, 11/624,351, 11/624,860, 11/265,059, 11/264,926, 11/164,936, 11/165,156, and 11/165,394. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.
2. Although the conflicting claims are not identical, they are not patentably distinct from each other. Refer to the tables below for an example of the mapped claim language that is similar in meaning and scope. Applicant is requested to contact the Examiner should Applicant require explicit mappings for each and every combination of the claim sets. However it is presumed that the rationale set forth below will easily translate over to the other claim sets and that the rationale is self-evident given how closely related these applications are.

Instant Application # 10/721,905	Application # 11/624,351
Independent claim 51 (unless otherwise noted). A method of real-time communication between a plurality of users, the method comprising:	Independent claim 1 (unless otherwise noted). A method of communication between first and second users using a system having respective first and second communication devices, each registered with at least one communication network and being capable of at least one communication type, the method comprising:
Providing a first user with collaboration	each registered with at least one

initiation software on an associated first communication device having defined communication capabilities	communication network and being capable of at least one communication type, the method comprising;
Keeping track of the communication capabilities of the first communication device;	4. causing registration of at least one communication service capability of the first communication device,
Allowing the first user to log in at the first communication device and connect to at least one communication network;	Allowing the first user to connect to at least one communication network by using the first communication device
61. the second communication device is a wireless device	The first communication device being configured for wireless communication
Associating the first user with the location of the first communication device;	Sending to the system, from the first communication device, information indicating the location of the first user to thereby enable the system to maintain at least one service record including at least the first user's location information
Causing display of a user identifier for at least the second user in a list on a display of the first communication device and allowing the first user to selected the displayed second user's identifier; and	Allowing the first user to request communication with the second user by selecting an identifier for the second user, from a list of displayed user identifiers displayed to the first user in a personal user directory,

55. allowing the first user to select a communication capability and wherein the real-time communication is further established based on the communication capability selection.	and by selecting one of a plurality of communication types
If the second user is not logged in indicating to the first user that the second user is not logged in	8. indicating to the first user if the second user has not logged in.
If the second user is logged in, responding to the selection by obtaining an address associated with a second communication device into which the user has logged in	In response to the request, causing retrieval of location information from a service record for the second communication device;
Using the obtained second user's address to enable real-time communication with the second user.	Initiating communication of the selected type from the first to the second device using the at least one communication network and the retrieved address information.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 37-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swinehart (Telephone Management in the Etherphone System, published May 1989) and Vin et al. (Multimedia Conferencing in the Etherphone Environment; hereinafter Vin) and Ahuja et al. (U.S. Patent Number 5,689,553; hereinafter Ahuja) and Harrison et al. (U.S. Patent 5,796,727; hereinafter Harrison) and Banks (America Online: A Graphics Based Success Evaluation, published January 1992) and Baumgartner et al. (U.S. Patent Number 5,195,086; hereinafter Baumgartner).**

Note the Swinehart and Vin references discuss the same system, the Etherphone system developed at the Xerox Palo Alto Research Center. The references are very much like multiple chapters in a book describing various aspects of the Etherphone system. Thus, it clearly would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine the two references as they describe the same system.

With regard to claims 30 and 39, Swinehart and Vin disclosed communication between first and second users using a system having respective first and second communication devices (e.g. Swinehart multipurpose workstations, pg 1, section 2), each registered with at least one communication network (Swinehart pg 1, section 2; "each workstation is connected to a communication network") and being capable of at least one communication type (e.g. Swinehart pg 1 introduction 1<sup>st</sup> ¶ "telephony, voice mail, voice annotation, and other multi-media document applications;" also see Vin pg 69 allowing video conferencing), the system comprising:

- one or more service programs for causing at least one computer to maintain at least one record of at least location information for where a first user is logged in



at a first communication device (Swinehart, pg 2, section 2.3 logging in tells the system which workstation each user is at, conferencing data is then routed to the appropriate workstations as needed; also see pg 4, section 3.2, “dynamic information linking users to workstations”); and

- one or more collaboration initiation programs for:
  - allowing a second user to log in at a second communication device and to connect to at least one network (Swinehart pg 1, section 2; “each workstation is connected to a communication network” and pg 2, section 2.3 “Logging in”);
  - presenting a user interface on a display associated with the second communication device, the user interface including at least one rolodex of user identifying entries (Swinehart, pg 3, section 2.5 and figure 8; arranging a conference and displaying the telephone directory for the particular user; “Telephone Directory for Karmen Foozle”), and
  - allowing the second user to select the first user from the user interface (Swinehart, pg 3, section 2.5 and figure 8; arranging a conference and selecting user Brodsky, Frances);
- wherein the one or more collaboration initiation programs and the one or more service programs are operable to:
  - keep track of the communication capabilities of the first communication device (Vin pg 72, columns 2 and 3 - Best effort conferencing; see specifically column 3 2<sup>nd</sup> ¶ “The system would determine the media set

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- dynamically based on hardware availability, forcing all participants to use the same media”),
- respond to the second user’s selection by causing retrieval of addressing information for the first user, which addressing information can be used to establish a connection between the first and second users (Swinehart, pg 2, section 2.3 logging in tells the system which workstation each user is at, conferencing data is then routed to the appropriate workstations as needed; also see pg 4, section 3.2, “dynamic information linking users to workstations”), and
- when such connection is established, enable real-time communication based on the communication capabilities of at least the first communication device, from the first user to be displayed on at least the display of the second communication device (Vin pg 72, columns 2 and 3 - Best effort conferencing; see specifically column 3 2<sup>nd</sup> ¶ “The system would determine the media set dynamically based on hardware availability, forcing all participants to use the same media”).

As cited above Vin disclosed keeping track of the communication capabilities of the communication devices and establishing the real-time communication based on the communication capabilities of the communication devices. Furthermore as additionally evidenced by Ahuja such a communication establishing scheme was widely known at the time of Applicant’s invention. In a similar conferencing system, Ahuja disclosed establishing conferences using any number of communication types such as audio, video, and data (Ahuja,

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Col 13, lines 62-67). Ahuja further disclosed tracking the communication capabilities for each of the communications devices in order to identify any mismatches in the media communications capabilities of the parties and thus ensure proper communication types are used when establishing a communications session (see inter alia Ahuja Col 14, lines 3-19). Thus, it clearly would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to track of the communication capabilities of each communication device and establish the real-time communication based on those communication capabilities, as disclosed by Ahuja, in order to identify any mismatches in the media communications capabilities of the parties and thus ensure proper communication types are used when establishing a communications session.

Swinehart disclosed indicating to the first user that the second user is not logged in if the second user is not logged in. For instance when the user is not logged in all conference requests to that user are routed to an attendant's workstation so that a message can be taken (see inter alia Swinehart pg 3, section 2.7). Furthermore as additionally evidenced by at least Banks it was widely known in the art at the time of the invention to notify users when other users not logged while establishing communications so the user is made aware of the fact that the communication session cannot be made at this time (see for instance Banks pg 247). Thus, it clearly would have been obvious to one of ordinary skill in the art at the time of Applicant's invention notify users when other users not logged while establishing communications so that the user is made aware of the fact that the communication session cannot be made at this time (Banks pg 247).

Swinehart and Vin failed to specifically recite that the user identifier is displayed in a list that is scrollable. Nonetheless Examiner takes official notice that scrollable lists were widely used at the time of Applicant's invention to allow users to access data that can not fit within a

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single window. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize a scrollable list for Swinehart's user rolodex, in order to ensure that the user will be able to view all the contacts even when they cannot fit within a single window.

Swinehart and Vin failed to disclose the use of wireless communication devices for establishing communications. Nonetheless the use of wireless networks for the transfer of voice/audio and other data communications was notoriously well known in the art at the time of Applicant's invention, as evidenced by at least Harrison (see inter alia Figure 2 and Col 5, lines 8-24 where mobile PCs utilize wireless communications to connect to various networks). The benefits of wireless connections as opposed to being tethered to a network via a physical cable are substantial and would clearly benefit many users by allowing them to stay connected from anywhere a wireless connection is available. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to extend the conferencing features of Swinehart and Vin to wireless environments, in order to allow users to connect to conferences from anywhere a wireless connection is available.

With regard to claim 38, Swinehart disclosed the communication includes real-time communication (see for instance the text on pg 3, figure 7 of Swinehart).

With regard to claim 40, Harrison disclosed the communication network is a WAN (see inter alia Figure 2).

With regard to claim 41, Swinehart disclosed allowing the second user to: select a new user from among a plurality of potential users; and add the new user to an existing

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communication (e.g. adding user to an existing conference, Swinehart pg 2, section 2.4 and Vin pg 73, Figure B “Invite”).

With regard to claim 42, Swinehart disclosed notifying the first user of an attempt by a third user to initiate a communication and allowing the first user to establish a communication with the third user (Swinehart pg 2, section 2.2 Figure 6; displaying the incoming communication request from the originating user “Frances Brodsky for Karmen” and allowing the user to “answer” the request and establish a communication session).

With regard to claim 43, Swinehart disclosed an indication of the attempt to initiate communications appear automatically on a user’s display (Swinehart pg 2, section 2.2 Figure 6; displaying the incoming communication request from the originating user “Frances Brodsky for Karmen” and allowing the user to “answer” the request and establish a communication session).

With regard to claim 44, Swinehart disclosed allowing the second user to send an e-mail to a first user (Swinehart pg 3, section 2.7 “electronic mail”).

With regard to claim 45, Vin disclosed the communication includes at least on image (e.g. Video).

With regard to claim 46, Vin or Ahuja disclosed keeping track of the communication capabilities is done by at least one server (see inter alia Vin pg 72, columns 2 and 3 - Best effort conferencing; see specifically column 3 2<sup>nd</sup> ¶ “The system would determine the media set dynamically based on hardware availability, forcing all participants to use the same media” or Ahuja Col 14, lines 3-19).

With regard to claims 47, Swinehart disclosed at least on communication device is a computer (e.g. Swinehart multipurpose workstations, pg 1, section 2).

With regard to claim 48, Examiner takes official notice that it was widely known in the art at the time of Applicant's invention to allow users to create and modify personal rolodexes so that they can easily organize and locate their contacts. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the system Swinehart and Vin to allow users to create and modify personal rolodexes so that they can easily organize and locate their contacts.

With regard to claim 50, Swinehart disclosed the personalized list includes at least one graphical icon representing a user (e.g. the clickable icon "Brodsky, Frances x4567" in Figure 8 Arranging a conference). Furthermore should one persuasively argue that a graphical icon is more than a text based icon, such as picture instead, then Examiner maintains that such a modification would be obvious in view of Baumgartner. In a similar conferencing system, Baumgartner disclosed establishing a conference by allowing users to click on a directory of pictures representing each user (see inter alia Baumgartner Figure 18 and Col 18, lines 57-62). Providing a picture for each user allows a user establishing a conference to easily identify the users they are attempting to connect with based on facial recognition. Thus, it would have been obvious to modify Swinehart's system to use a directory of pictures representing each user when establishing communications, as disclosed by Baumgartner, so that users establishing conferences can easily identify the users they are attempting to connect with based on facial recognition.

With regard to claim 51, Swinehart disclosed selecting a user includes clicking on an icon (e.g. the clickable icon "Brodsky, Frances x4567" in Figure 8 Arranging a conference).

With regard to claim 52, Vin disclosed the communication includes video (Vin pg 69 allowing video conferencing).

With regard to claim 55, Swinehart disclosed the location information includes address information (Swinehart, pg 2, section 2.3 logging in tells the system which workstation each user is at, conferencing data is then routed to the appropriate workstations as needed; also see pg 4, section 3.2, "dynamic information linking users to workstations").

With regard to claim 58, Swinehart disclosed the one or more collaboration initiation programs and the one or more service programs further are operable to allow the first user to indicate a willingness to receive requests for communications (Swinehart call filtering pg 2, section 2.2).

The remaining claims are rejected using a similar rationale as applied to the above claims.

#### *Conclusion*

4. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 15, 2007

  
GLENTON B. BURGESS  
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